

ARGUMENT:

Several differences exist between the prior art and the current embodiment which is under election (species 1-2 shown in Figures 1-6). The primary issue is correcting the claim language to avoid what the examiner considered as reading on the prior art. The invention is actually quite different in several respects from the prior art in structure (as seen by the differences in the drawings) and the claims as amended.

PRIOR ART

The prior art in question shows two containers on wheels. Both have wheels at the rear. One is clearly a designed to have a flat top with a cover, the text book 'frustro-conical shape' generally defined as an object which has the shape of a cone, but the top is cut off parallel to the base, also known as a "frustum" or "frustrum". The other is a rectangular container having a dome-type cover joined at an edge which is higher at the back than the front, but which is still defined by the function, the function being that as a cover for the container.

The applicant would suggest that if there is particular claim language which would allow for a claim to be issued, that the examiner take advantage of 37 CFR 1.605 in order to provide language which would otherwise not be objectionable in the issuing of this patent.

When evaluating the scope of claim, every limitation in the claim must be considered. In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

The claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966), requires that to make out a case of

obviousness, one must: (1) determine the scope and contents of the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) determine the level of skill in the pertinent art; and (4) evaluate any evidence of secondary considerations.

The mere possibility that either device could be modified or replaced such that it would lead to this specific embodiment taught in the current patent does not make it obvious unless the prior art suggests that the desirability of such a modification or replacement. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). Proper analysis under section 103 requires, inter alia, a consideration of whether the prior art would have suggested those in ordinary skill in the art that they should make the claim composition or device, or carry out the claim process. In fact, the prior art shows just the opposite.

There is no provision in the prior art for various horizontal positioning of the back of the bottom section. It is impractical given the disclosure in the prior art. This is better defined with limitations such as the limitations wherein the angle is less than 75° and the use of this reduced angle in conjunction with the wheels moving to different positions.

The bottom section fails to disclose:

Handles (26) which extend for a can or wheelbarrow (Figure 1 & Figure 3 respectively).

The handles and angle are required to allow the invention to function as a wheelbarrow interchangeably with a garbage can.

The function as a cover dictates the shape relative to the attachment mechanism and angle of descent. In this case, the cover does not disclose the limitations of

- a. an opening in the top of the top section;

- b. a handle (25) opposite the extended sides (5); or,
- c. an angle required to define the bottom section as a wheelbarrow.

The angle is crucial because the length dictated by the ratio of the angle to the sides allows the bottom to function as a wheelbarrow and not just a container with a top. The inventive step, never shown in the prior art, is not obvious or the subject of experimentation or design when no similar concept is shown or envisioned. Just because an angle has been invented before does not mean that the application of the angle to convert a garbage can to a wheel barrow, and the limitations inherent, is disclosed. In fact, just the opposite is true.

The consistent criteria in for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success viewed in light of the prior art. Hodosh v. Block Drug Co., 786 F.2d 1136, 1143, 229 USPQ 182, 187 (Fed. Cir. 1986). The question is not whether the differences between the claimed invention and the prior art would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1537, 218 USPQ 871, 877 (Fed. Cir. 1983). The prior art does not provide a mechanism for utilizing a combination of elements (angled tops, handles and movable wheels along with limitations inherent in each of these) as described in order to create a wheelbarrow garbage can leaf scoop combination and hence cannot be relied upon in order to disclose the invention or render it obvious in light of 103. Jones v. Hardy, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1983); Dillon, 919 F.2d at 692, 16 USPQ2d at 1901; In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)

Also the prior art fails to disclose the combined are angled top with a frictional fit around the perimeter.

Also, the placement and function of the handles on the top and bottom, when described adequately in the amended claims, show how they are structurally different and function differently from the prior art. The handles can be at the back or above the opening while still being attached to the bottom section to allow for the functions in conjunction with the angle limitations.

Using the language of the Board of Patent Appeals and Interferences and looking at the claim language clarifying the differences between what is shown in the prior art and the current claims, there is "no teaching, suggestion, or incentive in the applied references" which would have made it obvious to one of ordinary skill in the art to make the angle seen. Moreover, there is nothing in the prior art to "indicate that [the angle necessary for the function of the parts, handle movement from back to front or the removable top to make a wheelbarrow-garbage can conversion] would be considered by one of ordinary skill in the art to have been a result effective variable." The prior art patents cited do not envision "effective variables" to make this new result which is the key to making this invention something nonobvious.

These differences are not merely an "optimum" choice arrived at through routine experimentation, "but they change the fundamental nature of what the invention is and what it does."

The claims provide limitations on the elements in combination with a new outcome. The use of the particular parts and angles and the method taught in applying it to the invention of a convertible container was unknown but for the inventors disclosure. Ochiai, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). See also In re: Brouwer, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1995).

This is the step, reflected by the amended claims, whereby a container for holding bottles or a garbage can for filling and dropping bags is not the same as on the invention whereby a garbage can

can convert into a wheelbarrow with a scoop. Specific elements exist which when properly described differentiate this from the prior art and no amount of experimentation to optimize the function of the garbage can or the carrying can will function to change these into a completely different invention (not just an improved garbage can and not just an improved carrying can) without stumbling into the area of new invention.

The formation of a lip when the top of the top section is disconnected is not taught in the prior art or suggested by any of the prior art cited and it would be necessary to add art from unrelated patents, in affect to back into the invention using prior art which hind sight is not allowed. Similarly the combination of a movable wheelbarrow with a movable wheel axle relative to the angled face of the bottom section requires joining two unrelated disclosures.

The primary goal of the patent system is to encourage innovation and commercialization of technological advances. An invention satisfies the novelty requirement if it differs in any material way from what is known in the "prior art." An invention satisfies the nonobviousness requirement if a "person of ordinary skill in the art" would not have viewed the invention as having been obvious in view of the prior art at the time the invention was made. This is true of the combinations which would not be a suggested combination unless hindsight was used.

Element 2 in Figure 1 of Williams is an open base and there is also a top. There is a lid, the lid does not define an opening within that lid and hence it fails to show the combination of a lid at an angle with a top which can be opened (as opposed to lifting the lid off). This can be seen in Figure 6 item 18 which is the opening that is formed in the lid 2 top 17.

While the top in Williams may fit, it is not held frictionally in the same method as described in the claims, nor does it fit at an angle which allows a conversion of the use of the product between

two separate functions which is critical to the invention in Claim 5. Claim 5 has been amended in order to clarify the difference in structure.

Claim 2 has also been amended to better show how the handle functions differently, being a side handle in one aspect (Figure 1) and a forward handle in a separate aspect (Figure 3) in order to go along with the two functions of the bottom section; as either a garbage can base or a wheelbarrow.

Claim 12 is amended in order to show how the removable front cover is removable based solely on it's angular attachment in conjunction with the frictional contact so that it is removable and insertable along the perimeter of the top and in contact with the cooperating perimeter of the bottom.

Claim 13 and 14 have been amended in order to show the wheel position in Figure 2 and the wheel position in all of the figures of Williams is in a location and does not slide along the back. Item 2 is a lip. The description of the base rim 7 as notched is not for the purpose of changing the position of the axle relative to a slanted front and hence the claims do not show that the location of the axle relative to the length of the side 6, which is the base of the wheelbarrow conversion is targeted and the claim language of the application shows this. The slide is defined as being a slide along that rear base in order to clarify the language in claim 15 and is described in terms of location.

With regard to claim 17, the top with a removable cover and the perimeter is described in terms of how the interaction exists along the angular perimeter in order to further differentiate the patent when viewed with the opening within the top.

The location of the grip extending outward from the top perimeter and below the top perimeter is the difference in claim 19 from the language that was cited and the claims are amended in order to further reflect this change.

Paragraph Section 103 rejections:

While Hallisey shows a fixed top, the same being fixed at the back having an angle of less than 90 degrees to the lid, that is not a releaseable, which is described in this case. It would not be obvious to apply the different type of lid because of the different function which is desired between the Hallisey invention and the Williams invention, one being designed in order to hold a garbage can level with a snap on lid and the other merely providing a cover rotatable out of the way of the opening. This combination is neither suggested nor obvious in the prior art since the two elements would not function together and, in fact, one would teach away from the other. The reason is that the can preferably has a flat top and only becomes a wheelbarrow with a slanted top when the lid is removed. This combination is impossible without departing from the disclosure suggested by the prior art.

The language of claim 4 would not have been obvious, because the modification of Williams would include an angle described by the left and right side which, would have prevented it from holding a garbage can bag in the preferred manner and would be an inventive step.

The language is being misinterpreted, as best understood by the inventor, in stating that the left side and right side have a link wherein the angle extends less than the entire length of the left and right side. The back extends all the way to the end and forms an angle at that point which then forms a second angle down to the front as opposed to having the angle squared off. The claim language of claim 6 has been amended in order to attempt to clarify this difference. In the interpretation of claim 7, it is not considered to be an experimental issue, that the angle extends from one end to a point no closer than 6 inches from the back of the bottom section because this is not taught and the concept of an optimum value would require that some prior art teaches at least some similar aspect,

and in this case nothing of the type is indicated or even desirable.

The same is true as to claim 8. Where a particular design is totally novel, that is having the intersection of the two sides as shown, it cannot be said that just because an accidental width of material accomplishes something that it would render a functional change in structure obvious.

Hence the primary differences between the present invention and the prior art as taught is to have a container which has a frictionally connected top defining a closeable opening held at an angle of less than 75 degrees along the entire perimeter along the top and the bottom sections as opposed to having it attached with a hinged attachment at either point so that the top may be removed and replaced.

Also having an opening in the top so that the angled top can provide a flat garbage can opening and a scoop, is not taught in the prior art. Also, the invention having a handle 25 at the garbage can back of the device as a garbage can and in position above the top of the back section for a wheelbarrow handle is not taught.

All of these elements are emphasized in the claims as we have written an order to differentiate them from the prior art.

CONCLUSION

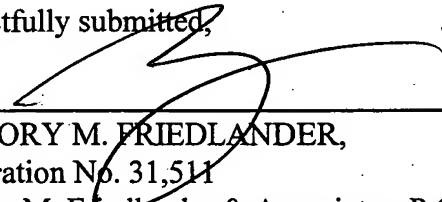
For all of the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

No additional fee is believed necessary.

The commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account 06-2129 in the name of Gregory M. Friedlander.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit account 06-2129.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United State Postal Service as Express Mail No.: EV 278560034 US in an envelope addressed to: Commissioner of Patents and Trademarks, Mail Stop Non-Fee Amendment, Alexandra, VA 22313 on the 17 day of February, 2006.



GREGORY M. FRIEDLANDER

IN THE DRAWINGS

No changes were required in the drawings.

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